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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/930,601 | 08/14/2001 | Mark Manuel | 199-003 | 1765 |

7590

08-06/2004

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/930,601 | Applicant(s) MANUEL, MARK | |
| | Examiner Donald Heckenberg | Art Unit 1722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☐ Claim(s) 1-11 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The amendment filed on July 19, 2004 in response to the previous Office Action has been received. Upon consideration of Applicant's arguments, the previous rejection under 102(e) with the Bak reference has been determined to be overcome by Applicant's affidavit. However, upon reconsideration of the other prior art of record in the case, it has been determined that other references may be applied against the pending claims. Accordingly, the finality of the previous Office Action is withdrawn, and a new action on the merits follows.

It is noted that the amendment of July 19, 2004 conflicting instructions are presented with respect to claims 15-18, 23 and 24. The amendment initially states that these claims are to be canceled. However, in the clean copy of the claim provided with the response, the status identifier of claims 15-18 indicates that these claims are "previously presented" as opposed to "canceled." Further, there appears to have been amendments made to the claims which are not indicating with the status identifier "amended" or by appropriate claim marking. For example, claim 18 has been made into an independent method claim, and claim 19 has been made to depend from claim 18. Still further, the clean copy does not list or indicate any status for claims 23 and 24. For purposes of this action, it will be assumed that the claims are as presented in the clean

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copy of the claims, with claims 15-18 still pending as they are indicated, and that claims 23 and 24 have been canceled as they is not present in the clean copy. However appropriate clarification and correction is required.

It is further noted that the status identifier for several other claims appears to be in error. For example, claim 1 is listed as "previously presented." However, it appears as though this claim has yet to be amended in the prosecution of the application and therefore must be identified as "original." Appropriate clarification and/or correction to this problem is required as well.

2. As claims 18-22 are still considered pending, they are withdrawn from further consideration as being directed to an invention nonelected without transverse in the response filed on May 27, 2003. Note, this grouping includes that claim 18 has been amended to correspond to what was previously claim 19, and claim 19 has been amended to depend from claim 18.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (U.S. Pat. No. 5,792,492; previously of record).

Takahashi discloses an optical disk molding tool. The tool comprises a first sectional member (48) and a cooperating second sectional member (39) which is selectively coupled to the first sectional member using a bolt (53). The first sectional member has a first portion, and the second sectional member has a second portion which is aligned with the first portion when the second sectional member is coupled to the first sectional member and which cooperates with the first portion to a passage (40) within the tool (see fig. 1). More specifically, the first and second portions comprise indented (or depressed) channels which form the passages (fig. 1), with the indented channels being substantially identical. Further, the first and second channels are longitudinally coextensive and terminate within the tool (fig. 1).

It is noted that claims 1-11 recite that the passage formed in the tool is a "cooling passage." The effect of the passage whether it be cooling or heating is dependent on the material sent through the passage, and therefore the intended use of the

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tool. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In the instant case, as described above Takahashi discloses a tool with passages provided for the circulation of a heat transfer fluid. Thus, Takahashi could be used in a manner that the passages are cooling passages, and therefore anticipates the intended use recited within the claims.

It is noted that claims 6-11 are in product by process format. The determination of patentability in product by process claims is based on the product itself. The patentability of a product does not depend on its method of production. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 173 USPQ 685 (Cust. & Pat. App. 1972); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (Cust. & Pat. App. 1969); see also MPEP § 2113. In the instant case, as described above Takahashi discloses a tool with all of the actual structural features recited in claims 6-11. Accordingly, Takahashi anticipates these product by process claims.

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5. Claims 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Vandergrift (U.S. Pat. No. 1,539,887; previously of record).

Vandergrift discloses a molding tool. The molding tool comprises a first member (2) and a second member (3). A spacer member (7) is provided between the first and second members to form a cooling passage (8), with the spacer member attached to the first member (see figure 5). The spacer member has a rectangular cross sectional area (see figure 3), and it is evident from the scale shown in figures 1-2 that the spacer of Vandergrift has a thickness of greater than 0.001 inches. Vandergrift further discloses the second member to be attached to the first member (p. 1, ll. 101-104). Thus, the first member is stationary with respect to the first member.

As noted above in the rejection of claims under anticipation by Takahashi, the determination of patentability in product by process claims is based on the product itself. As Vandergrift discloses all of the product-structural limitations of claims 15-17, and therefore anticipates these claims.

6. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Miller (U.S. Pat. No. 3,416,766; previously of record).

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Miller discloses a molding tool. As shown in figure 2, the tool comprises a first member (5) having at least one groove therein. The tool further comprises a second member (4) which is coupled to the first member. The second member has flat face which overlays the groove thereby forming a cooling passage (6 and 7). Miller further discloses the second member to be attached to the first member (col. 2, ll. 5-7). Thus, the first member is stationary with respect to the first member.


7. Claim 12 is allowed. See the reasons for indicating allowable subject matter in the previous Office Action.

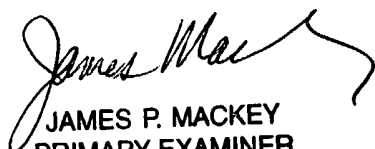
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
A.U. 1722
8-4-04


JAMES P. MACKEY
PRIMARY EXAMINER
8/5/04